

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* HARUMITSU TOYODA

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Appeal No. 1998-2818  
Application 08/550,521

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HEARD: January 27, 2000

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Before STAAB, NASE and GONZALES, *Administrative Patent Judges*.

STAAB, *Administrative Patent Judge*.

*DECISION ON APPEAL*

This is a decision on an appeal from the examiner's final rejection of claims 1-14, all the claims in the application.

*The Invention*

Appellant's invention pertains to a pull-on type disposable diaper. Independent claim 1, a copy of which is found in an appendix to appellant's brief, is illustrative of

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the appealed subject matter.

### *The Applied Prior Art*

The references of record relied upon by the examiner in support of rejections under 35 U.S.C. § 103 are:<sup>1</sup>

Robertson et al. (Robertson)	4,963,140	Oct. 16, 1990
Buell et al. (Buell)	5,151,092	Sep. 29, 1992
Daio, (Daio '051) Japanese application	3,176,051	Jul. 31, 1991
Daio, (Daio '052) Japanese application	3,176,052	Jul. 31, 1991
Uni-Charm Corp. (Uni-Charm) Japanese application	4,371,148	Dec. 24, 1992
Kao Corp (Kao) Japanese application	5,192,366	Aug. 3, 1993

### *The Rejections*

Claims 1, 3, 4 and 9-12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Uni-Charm or Kao, or, in the alternative, as being unpatentable over Uni-Charm or Kao in view of Buell.

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<sup>1</sup> Our understanding of the Japanese language patent documents relied upon by the examiner in support of the appealed rejections is derived from translations prepared on behalf of the PTO, copies of which are attached to this opinion.

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Claims 2, 5-7, 13 and 14 stand rejected under 35 U.S.C.  
§ 103 as being unpatentable over Uni-Charm, or, in the

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alternative, as being unpatentable over Uni-Charm in view of Buell.

Claim 8 stands rejected under 35 U.S.C. § 103 as being unpatentable over Uni-Charm or Kao in view of Daio '051, Daio '052 and Robertson, or, in the alternative, as being unpatentable over Uni-Charm or Kao in view of Daio '051, Daio '052 and Robertson, and further in view of Buell.

*Preliminary Matters*

The "Grounds of Rejection" section of the answer (pages 5 and 6) refers us back to Paper No. 17 (the final rejection in the present application) and "a previous Office Action, Paper No. 2" (the initial office action in the parent application) for statements of the rejections. In addition, the "Response to Argument" section of the answer (pages 6-9) for the most part consists of merely cross referencing various pages and lines of papers filed by appellant (Paper Nos. 13 and 16) to various pages and lines of previous office actions (Paper Nos. 14 and 17). These previous office actions in turn refer to other office actions.

MPEP § 1208, in pertinent part, reads as follows:

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Examiners may incorporate in the answer their statement of the grounds of rejection merely by reference to the final rejection (or a *single* other action on which it is based, MPEP § 706.07). Only those statements of grounds of rejection as appear in a *single* prior action may be incorporated by reference. An examiner's answer should not refer, *either directly or indirectly*, to more than one prior Office action. Statements of grounds of rejection appearing in actions other than the aforementioned *single* prior action should be quoted in the answer. The page and paragraph of the final action or other *single* prior action which it is desired to incorporate by reference should be explicitly identified. [Emphasis added.]

As is clear from the above, the examiner's answer in this application does not comply with, *inter alia*, the requirement of MPEP § 1208 that only those statements of grounds of rejection as appear in a *single* prior action may be incorporated by reference, and the requirement of MPEP § 1208 that an examiner's answer should not refer, *either directly or indirectly*, to more than one prior office action. We should not have to continually refer to appellant's brief, previous office actions, and papers previously filed by appellant in order to determine the examiner's position with respect to the obviousness issues raised in this appeal. In the interest of judicial economy, we shall, in this instance, proceed to

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decide the appeal on the merits notwithstanding the examiner's clear disregard for established office procedure in formulating her answer.

### *Opinion*

With reference to Figures 1 and 2, claim 1, the only independent claim on appeal, calls for a pull-on disposable diaper comprising a rectangular body (10), a first pair of expansible side panels (20, 20) and a second pair of expansible side panels (20', 20'). The side panels are separately formed of a material different from the material of the topsheet (11) of the body. Affixing means are provided for affixing the side panels to longitudinal sides of the body means. In addition, the side panels are joined to each other to define a waist opening portion (15), a pair of leg openings (17, 17'), and a body-surrounding portion (E). Claim 1 also calls for first elastic members (23, 23') arranged on an area (D) adjacent the waist opening portion and second elastic

members (21, 21') arranged on stomach-side and back-side portions of the diaper, with each of the first and second elastic members having opposing ends that terminate within the rectangular body.

We take up first for consideration the § 103 rejections which do not rely in part on Buell. These include the rejection of claim 1, 3, 4 and 9-12 as being unpatentable over Uni-Charm or Kao, the rejection of claims 2, 5-7, 13 and 14 as being unpatentable over Uni-Charm, and the rejection of claim 8 as being unpatentable over Uni-Charm or Kao in view of Daio '051, Daio '052 and Robertson.

Uni-Charm and Kao, the examiner's primary references, each pertain to a pull-on diaper comprising a layered body defining a waist opening portion, a pair of leg openings, and a body-surrounding portion. As can be readily discerned upon review of Figure 2 of Uni-Charm and Figures 1, 2, 4 and 5 of Kao, in each reference the body of the diaper includes unitarily formed ear portions that are joined together at their edges to form the waist opening and leg openings. In addition, each diaper includes elastic members arranged in areas adjacent the waist opening, which elastic members

terminate at the edges of the unitarily formed ear portions.

In rejecting claim 1 as being unpatentable over Uni-Charm or Kao, the examiner considers that the ear portions of the diapers of Uni-Charm and Kao correspond to the claimed side panel portions. The examiner concedes on page 3 of the final rejection that these ear portions are not separately formed apart from their respective body portions and then affixed thereto. The examiner takes the position, however, that appellant does not disclose the criticality of this form of construction and that, accordingly, it have been would an obvious matter of design choice to separately form the side panels of Uni-Charm or Kao since such modification would have involved a mere change from unitarily formed to separately formed parts "which is recognized by case law as being generally within the level of ordinary skill. . . . In the instant, crowded and commercially viable diaper art such changes would likewise be recognized as being within the level of ordinary skill in the art" (answer, page 4).

We will not support this rationale. In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re*



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*Rijckaert*,

9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1990). In order to establish a *prima facie* case of obviousness, the prior art teachings must be sufficient to suggest to one of ordinary skill in the art making the modification needed to arrive at the claimed invention. See, for example, *In re Lulu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984). Here, the examiner tacitly admits that neither Uni-Charm nor Kao provides a teaching or suggestion of forming the side panels separately from the body of the diaper. The examiner seeks to overcome this deficiency in Uni-Charm and Kao by stating that the differences between the claimed subject matter and the prior art references are obvious matters of design choice, without providing any evidence as to why this might be the case. However, the subjective opinion of the examiner without evidence in support thereof does not provide a factual basis upon which the legal conclusion of obviousness may be reached. See *In re GPAC Inc.*, 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir.

1995) and *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). In short, Uni-Charm and Kao, when taken alone, do not provide the factual basis necessary to support the examiner's conclusion of obviousness.

Concerning the examiner's position that appellant has not established the criticality of forming the side panels separately, we observe that criticality is not a requirement of patentability. See *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1556, 220 USPQ 303, 315 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). We also note the examiner's position that appellant's specification does not mention the advantage of allowing the use of one size body for wearers of different waist sizes asserted by appellant on page 4 of the brief as flowing from the use of separately formed side panels. The examiner implies that this is significant. Assuming for the sake of argument that the examiner's position that the asserted advantage of the claimed arrangement is not found in the specification, simply because an argument asserting an advantage of the claimed invention over the prior

art is not included in the specification does not mean that such argument may be dismissed, as the examiner appears to believe. See *In re Chu*, 66 F.3d 292, 298, 36 USPQ2d 1089, 1094 (Fed. Cir. 1995) (held, in case where examiner and Board alleged that difference between prior art and appealed claim was "design choice," that there is no basis supporting position that a patent applicant's evidence or argument traversing rejection must be contained within specification in order to be considered).

On pages 7 and 8 of the answer, the examiner, citing 37 CFR § 1.111 and MPEP § 714.02, states that some of the arguments advanced in appellant's brief are untimely because they were not previously presented. Suffice to say that this viewpoint finds no support in 37 CFR § 1.111, MPEP § 714.02 or any other provision of PTO practice.

In light of the foregoing, we will not sustain the examiner's rejection of claim 1, or claims 3, 4 and 9-12 that depend therefrom, as being unpatentable over Uni-Charm or Kao. We also will not sustain the examiner's rejection of claims 2, 5-7, 13 and 14, which depend from claim 1, as being

unpatentable over Uni-Charm. Concerning the rejection of dependent claim 8 as being unpatentable over Uni-Charm or Kao in view of Daio '051, Daio '052 and Robertson, we have carefully reviewed each of the additionally cited references relied upon in this rejection but find nothing therein that makes up for the deficiencies of Uni-Charm and Kao noted above in our discussion of claim 1. Therefore, we also will not sustain the rejection of claim 8 as being unpatentable over Uni-Charm or Kao in view of Daio '051, Daio '052 and Robertson.

We now turn to the § 103 rejections that rely in part on Buell. These include the rejection of claims 1, 3, 4 and 9-12 as being unpatentable over Uni-Charm or Kao in view of Buell, the rejection of claims 2, 5-7, 13 and 14 as being unpatentable over Uni-Charm in view of Buell, and the rejection of claim 8 as being unpatentable over Uni-Charm or Kao in view of Daio '051, Daio '052 and Robertson, and further in view of Buell.

The examiner alternatively contends that it would have been obvious to separately form the ear or side panel portions of the diapers of Uni-Charm and/or Kao in view of the

teachings of Buell. We agree. Buell pertains to a flat-type diaper having elasticized side panels 30 that provide a more comfortable and contoured fit and that allow the diaper to "self-adjust" during wear (column 33, lines 61-67; column 34, lines 12-20). The elasticized side panels 30 may be disposed on the back-side waist portion 58, the stomach-side waist portion 56, or both (column 34, lines 17-22). Further, the elasticized side panels 30 may be formed as a unitary structures with the other elements of the diaper, or as separate and discrete elements joined thereto (column 33, lines 54-61; column 34, lines 47-56). In light of these teachings, we share the examiner's view that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to separately form the side panels or ears of the diapers of Uni-Charm and/or Kao as an alternative way of making the diapers of the primary references, suggestion being found in Buell's teachings in this regard.

Claim 1 also calls for the side panels to be formed of a material "different from" the material of the topsheet of the body of the diaper. The examiner has found (final rejection, page 4, lines 17-19), and appellant has not disputed (brief,

page 16), that Buell teaches "discreet [sic, discrete] but affixed ear flaps of different materials." Thus, on the record before us, we will accept the examiner's unchallenged finding that Buell discloses side panels made of a material that is different from the material of the topsheet of the diaper.<sup>2</sup> Based on these teachings, we conclude that in separately forming the side panels of Uni-Charm and/or Kao, it would have been further obvious to carry forward Buell's teaching of making the side panels and topsheet of different

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<sup>2</sup> In any event, appellant's specification does not disclose in what way the material of the side panels differs from the material of the topsheet. Accordingly, giving this claim language its broadest reasonable meaning (*see, for example, In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)), the material of the side panels may differ from the material of the topsheet in any number of ways and still fall within the scope of the claims. For example, the rather broad language of claim 1 in this regard covers diaper elements that are made from laminates that differ as to one or more of their constituent layers, such as disclosed by Buell at side panels 30 comprising panel members 90 versus topsheet 24 that does not include such panel members. The broad language of claim 1 also covers diaper elements that are made of the same starting material and thereafter processed differently to obtain different properties, such as disclosed by Buell at side panels 30 that are subjected to mechanical stretching to provide a "zero strain" stretch laminate in to improve their stretchability (column 11, lines 21-34). Thus, the side panels 30 of Buell are considered to be made from a material that differs from the material of the topsheet.

materials, suggestion being found in the self evident advantage of more easily adapting each of these components to its intended purpose (e.g., stretchability of side panels versus liquid permeability of the topsheet).

Claim 1 additionally requires that the ends of the first and second elastic members provided in the diaper terminate within the diaper body. This construction is shown in Buell, wherein the diaper may have elastomeric members 76 and resilient members 77 in the area around the waist opening that terminal short of the elasticized side panels 30. In our opinion, it would follow from both the teachings of Buell and as a matter of common sense that the elastic members 9a, 9b of Uni-Charm and/or the elastic members 10, 14 of Kao should be terminated within the body of the diaper upon forming the side panels of the primary references separately from the body in order to more easily adapt each of the diaper components to its intended purpose.

In light of the above, we will sustain the examiner's rejection of claim 1 as being unpatentable over Uni-Charm or Kao in view of Buell.

Appellant's argument (brief, pages 15-19) directed to the

rejection of claim 1 further in view of Buell have been considered. Our views with respect to the majority of these arguments should be clear from our discussion above. In addition, we do not agree with appellant that the ordinarily skilled artisan would not turn to Buell's flat-type diaper for a suggestion to modify the pull-on type diapers of Uni-Charm and/or Kao. In particular, Buell's reference at column 34, lines 23-47, to the side panels of a particular prior art pull-on diaper as an example of the type of side panels that may be utilized in Buell shows a recognition of the fact that, generally speaking, features of pull-on diapers may be incorporated into flat-type diapers, and vice versa.<sup>3</sup>

We will also sustain the examiner's rejection of claim 9 as being unpatentable over Uni-Charm or Kao in view of Buell. Claim 9 additionally calls for the absorbent core of the body to be rectangular. To provide an absorbent core of various

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<sup>3</sup>U.S. Patent 4,938,753 to Van Gumpel, mentioned in Buell at column 34, lines 47-58, and in particular the Figure 5A embodiment thereof, would appear to be closer to the claimed subject matter of the present application than either Uni-Charm, Kao, or Buell. In the event of further prosecution, the examiner may wish to consider the patentability of the claims in light of this prior art reference.



shapes, including rectangular, is well known in the art, as shown by Buell at column 8, lines 57-59. The incorporation of a rectangular absorbent core in Uni-Charm or Kao would have been further obvious in view of such a showing.

The rejection of claims 10-12 as being unpatentable over Uni-Charm or Kao in view of Buell likewise will be sustained. Each of these claims specifies a particular affixing means for joining the separately formed side panels to the diaper body. Buell teaches that each one of the specified affixing means is a generally accepted way of joining together components of disposable diapers. See, for example, column 9, lines 37-44 and lines 62-66; column 21, lines 46-51; and column 42, lines 42-48 of Buell. It would have been obvious to one of ordinary skill in the art to join the separately formed side panels of Uni-Charm or Kao in any of ways called for in claims 10-12 in view of Buell's teaching in this regard.

Claim 8 depends from claim 1 and further calls for a discarding tape provided on the backsheet for securing a rolled-up diaper for disposable, a feature shown to be conventional by Daio '051 at element 32, by Daio '052 at element 32, and by Robertson at element 868. The

incorporation of this feature into either one of Uni-Charm or Kao as a further enhancement thereof would have been obvious to one of ordinary skill in the art in view of these teachings. It follows that we also will sustain the examiner's rejection of 8 as being unpatentable over Uni-Charm or Kao in view of Daio '051, by Daio '052 and by Robertson, and further in view of Buell.

We will not sustain the rejection of claims 2, 5-7, 13 and 14 as being unpatentable over Uni-Charm in view of Buell, or the rejection of claims 3 and 4 as being unpatentable over Uni-Charm or Kao in view of Buell. Claim 2 calls for the first elastic members to be arranged substantially parallel to the peripheral edge of the waist opening and for the second elastic members to cooperatively form loops. Claims 3, 4, 13 and 14, in one form or another, call for the first and second elastic members to possess different elastic properties. Claims 5-7 set forth that the side panels are formed of longitudinally arranged alternating expansible and non-expansible portions.<sup>4</sup> The examiner has not indicated, and it

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<sup>4</sup>Consistent with appellant's disclosure, we consider the longitudinal direction of the side panels to be parallel to

is not apparent to us, where these features are taught in the references cited against the claims. Accordingly, the examiner has failed to meet her initial burden of establishing a *prima facie* case of obviousness of these claims.

*Summary*

The rejection of claims 1, 3, 4 and 9-12 as being unpatentable over Uni-Charm or Kao is reversed.

The rejection of claims 2, 5-7, 13 and 14 as being unpatentable over Uni-Charm is reversed.

The rejection of claim 8 as being unpatentable over Uni-Charm or Kao in view of Daio '051, Daio '052 and Robertson is reversed.

The rejection of claims 1, 3, 4 and 9-12 as being unpatentable over Uni-Charm or Kao in view of Buell is affirmed as to claims 1 and 9-12, but is reversed as to claims 3 and 4.

The rejection of claims 2, 5-7, 13 and 14 as being unpatentable over Uni-Charm in view of Buell is reversed.

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the opposed longitudinal sides of the rectangular body, as set forth in claim 1.

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The rejection of claim 8 as being unpatentable over Uni-Charm or Kao in view of Daio '051, Daio '052 and Robertson, and further in view of Buell is affirmed.

The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

*AFFIRMED-IN-PART*

	)	
LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
JEFFREY V. NASE	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JOHN F. GONZALES	)	
Administrative Patent Judge	)	

Birch, Stewart, Kolasch and Birch  
P. O. Box 747  
Falls Church, VA 22040-0747

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